

### **REMARKS**

Claims 1-8 are currently pending in the present application.

#### **Borokov does not disclose “excision”**

The Examiner has rejected claims 1-3 and 6 as anticipated under 35 U.S.C. 102(b) by Borokov, et al. (WO0111058). Borokov does not disclose use of an excisionase to **completely remove** intervening sequences. Borokov retains residual “recombinase sites”:

Borokov Product = ~R1-F1-R1-F2-R2-....-FN-RN-R1~

The present invention uses a combination of recombinases and excisionases to assemble the DNA and then remove the vector and recombinase site leaving a series of fragments **without** intervening DNA sequences:

Disclosed Product = ~F1-F2-F3-....-FN~

Borokov does not disclose site specific excision sites “**oriented in an appropriate orientation for excision**” that will “bring the second fragment **adjacent** to the first fragment.” Borokov does not anticipate the current claims because Borokov does not disclose each and every element of the claimed invention.

#### **Declaration of Dr. Bennett antedates Cheo**

The Examiner has rejected claims 4, 5, 7, and 8 as obvious under 35 U.S.C. 103(a) as being unpatentable over Borokov (ibid) in light of Cheo, et al. (US2002007051). According to MPEP §2136.05, “When a prior U.S. patent, U.S. patent application publication, or international application publication is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by **antedating the filing date** (see MPEP § 2136.03 regarding critical reference date of 35 U.S.C. 102(e) prior art) of the reference by submitting an affidavit or declaration under 37 CFR 1.131.”

The Applicant’s present invention was conceived and reduced to practice prior to the filing date of US2002007051 by Cheo. The attached Declaration under USC 1.131 by Dr. Bennett describes the recombination system and its use. The attached Exhibits A & B demonstrate the invention was conceived and reduced to practice prior to December 10, 1999. Therefore Cheo is removed as a reference.

### **Amended Claims require “Excisionase”**

The claims as amended specifically state that the “site specific excision sites are oriented in an appropriate **orientation for excision** with undesired vector sequences therebetween.” The claimed method further requires “completely remove the undesired vector sequences including both first excisionase sites and bring the second fragment directly adjacent to the first fragment.” Although Cheo has been antedated and no longer qualifies as art under §102(e) or §103, Cheo uses methods similar to Borokov for modifying recombinase sites and improving specificity. This specificity is required to prevent recombination with residual recombinase sites. Neither Borokov or Cheo describe the methods of the current invention as claimed because neither completely removes the excisionase site and leaves the desired fragments **adjacent** to each other.

### **CONCLUSION**

The references cited do not disclose an excisionase reaction that **removes the vector sequences and excisionase sites** leaving the product DNA fragments **adjacent** to each other. Therefore each and every element of the claimed invention is not disclosed, anticipated or obvious.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance, and favorable action is hereby requested. If a telephone interview would be of assistance in advancing prosecution of the subject application, the Examiner is requested to telephone the undersigned at the number provided below. Applicant believes Extension of Time and Request for Continued Examination fees are currently due in the amount of \$905.00. The Commissioner is hereby authorized to charge fees due or credit overpayments to Deposit Account No. 50-3420, Attorney Docket No. 31175413-003002 (HOUMDB).

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Respectfully submitted,

BAKER & MCKENZIE LLP

By /Michael D. Berger/

Michael D. Berger Ph.D., Patent Agent

Registration No.: 52,616

Pennzoil Place, South Tower

711 Louisiana, Suite 3400

Houston, Texas 77002-2746 USA

Tel: +1 713 427 5031

Fax: +1 713 427 5099

Attorneys For Applicant